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DEC 04 2009

OFFICE OF PETITIONS

In re Application of :
Lawrence A. Shimp et al. : DECISION ON APPLICATION
Application No. 10/614,448 : FOR PATENT TERM ADJUSTMENT
Filed: July 7, 2003 :
Attorney Docket No.285-180 PCT:
CIIP

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)" filed September 9, 2009. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred sixty-five (165) days to two hundred seventy-three (273) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct patent term adjustment determination at the time of the mailing of the notice of allowance is **273 days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On June 9, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 165 days. On September 9, 2009, applicant timely submitted the instant application for patent term adjustment¹.

¹ The Office records show that the issue fee was also received on September 9, 2009.

Applicant disputes the period of adjustment of 479 days entered pursuant to 37 CFR 1.702(a)(1) and 1.703(a)(1) for Office delay in failing to mail the first Office action under 35 U.S.C. 132 no later than 14 months after the actual filing date of the application. Applicant asserts that 479 days of patent term adjustment under 37 CFR 1.702(a)(1) and 1.703(a)(1) is in error because the Office failed to appreciate that the Restriction Requirement mailed on December 30, 2005, was vacated by the Restriction Requirement mailed April 17, 2006. Applicant contends that the April 17, 2006, mailing date of the Restriction Requirement should have been used to calculate the period of adjustment pursuant to 37 CFR 1.702(a)(1) and 1.703(a)(1).

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 154(b)(1)(A)(i) provides that:

— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after—

(I) the date on which an application was filed under section 111(a) of this title; or

(II) the date on which an international application fulfilled the requirements of section 371 of this title[.]

37 CFR 1.702 provides that:

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the

application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application[.]

37 CFR 1.703 provides, in pertinent part, that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first[.]

OPINION

Applicants' arguments and evidence have been considered and are well taken. In light of the application history, it has been determined that the period of adjustment for Office delay pursuant to 37 CFR 1.702(a)(1) is 587 days. The Office mailed a Restriction Requirement on December 30, 2005. On April 17, 2006, the Office mailed another Restriction Requirement that stated, in pertinent part, that:

1. Examiner appreciates courtesy extended by applicant's representative to point out to the Examiner in a telephone interview on 23 January 2006 that the Election Requirement in Office Action mailed 30 December 2005 does not encompass all the claims presented for examination in Applicant's Preliminary amendment filed 09 October 2003.

2. In view of the telephonic interview cited, *supra*, Examiner herewith vacates the Election/Restriction Requirement in the Office action of 30 December 2005. A new Office Action follows.

Excerpt taken from Restriction Requirement mailed April 17, 2006, pg. 3.

As the Restriction Requirement mailed December 30, 2005, was vacated and a new Restriction Requirement mailed on April 17, 2006, the Restriction Requirement mailed April 17, 2006, is the Office action under 35 U.S.C. 132 that should have been used in calculation of the period of adjustment under 37 CFR 1.702(a)(1). Accordingly, the period of adjustment under 37 CFR 1.702(a)(1) of 479 days will be removed and period of 587 days will be entered.

The \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to the patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen

Day : Thursday
Date: 12/3/2009

PALM INTRANET

Time: 16:50:31

PTA Calculations for Application: 10/614448

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|--------------------------|------------|-------------------------|-----|
| Application Filing Date: | 07/07/2003 | PTO Delay (PTO): | 479 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 314 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 273 |
| PTO Delay Adjustment: | 108 | | |

File Contents History

| Number | Date | Contents Description | PTO | APPL | START |
|--------|------------|---|-----|------|-------|
| 103 | 12/03/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | 587 | | |
| 102 | 12/03/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 479 | |
| 91 | 06/09/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 87 | 05/15/2009 | FILING RECEIPT - CORRECTED | | | |
| 85 | 05/14/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 84 | 05/14/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 83 | 05/14/2009 | ISSUE REVISION COMPLETED | | | |
| 82 | 05/14/2009 | DOCUMENT VERIFICATION | | | |
| 81 | 10/01/2003 | REFERENCE CAPTURE ON IDS | | | |
| 80 | 10/01/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 79 | 05/11/2009 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 78 | 05/08/2009 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 77 | 05/06/2009 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 76 | 05/14/2009 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 75 | 05/11/2009 | NOTICE OF ALLOWABILITY | | | |
| 74 | 02/24/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 73 | 03/06/2009 | DATE FORWARDED TO EXAMINER | | | |
| 72 | 02/24/2009 | RESPONSE AFTER NON-FINAL ACTION | | 119 | 68 |
| 71 | 02/24/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 70 | 02/17/2009 | MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT | | | |

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|------|------------|---|--|-----|----|
| 69 | 12/04/2008 | DATE FORWARDED TO EXAMINER | | | |
| 68.1 | 10/28/2008 | INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION | | | |
| 68 | 10/28/2008 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 67 | 07/28/2008 | MAIL NON-FINAL REJECTION | | | |
| 66 | 07/21/2008 | NON-FINAL REJECTION | | | |
| 65 | 04/18/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 64 | 04/18/2008 | REFERENCE CAPTURE ON IDS | | | |
| 62 | 04/18/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 17 | 60 |
| 61 | 05/09/2008 | DATE FORWARDED TO EXAMINER | | | |
| 60 | 04/01/2008 | RESPONSE AFTER NON-FINAL ACTION | | 5 | 58 |
| 59 | 04/18/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 58 | 12/27/2007 | MAIL NON-FINAL REJECTION | | | |
| 57 | 12/21/2007 | NON-FINAL REJECTION | | | |
| 56 | 10/09/2007 | DATE FORWARDED TO EXAMINER | | | |
| 55 | 09/26/2007 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 54 | 10/09/2007 | DATE FORWARDED TO EXAMINER | | | |
| 53 | 09/26/2007 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 52 | 10/09/2007 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 51 | 09/26/2007 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 50 | 07/27/2007 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 49 | 07/23/2007 | FINAL REJECTION | | | |
| 48 | 10/01/2003 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 47 | 10/01/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 46 | 05/09/2007 | DATE FORWARDED TO EXAMINER | | | |
| 45 | 05/03/2007 | RESPONSE AFTER NON-FINAL ACTION | | 143 | 40 |
| 44 | 04/03/2007 | MAIL NOTICE OF INFORMAL OR NON- RESPONSIVE AMENDMENT | | | |
| 43 | 12/28/2006 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 42 | 12/29/2006 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 41 | 12/28/2006 | DATE FORWARDED TO EXAMINER | | | |
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| 40.1 | 12/11/2006 | INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION | | | |
| 40 | 12/11/2006 | RESPONSE AFTER NON-FINAL ACTION | | 30 | 37 |
| 39 | 12/11/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 38 | 10/12/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 37 | 08/11/2006 | MAIL NON-FINAL REJECTION | | | |
| 36 | 08/07/2006 | NON-FINAL REJECTION | | | |
| 35 | 05/24/2006 | DATE FORWARDED TO EXAMINER | | | |
| 34 | 05/19/2006 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 33 | 04/17/2006 | MAIL NOTICE OF WITHDRAWN ACTION | | | |
| 32 | 04/17/2006 | MAIL RESTRICTION REQUIREMENT | | | |
| 31 | 01/23/2006 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 30 | 04/14/2006 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 29 | 04/14/2006 | LETTER WITHDRAWING / VACATING OFFICE ACTION | | | |
| 22 | 12/30/2005 | MAIL RESTRICTION REQUIREMENT | 479 | | -1 |
| 21 | 12/27/2005 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 20 | 06/28/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 19 | 08/12/2004 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 18 | 01/14/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 17 | 10/09/2003 | PRELIMINARY AMENDMENT | | | |
| 16 | 01/14/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 15 | 12/04/2003 | APPLICATION RETURN FROM OIPE | | | |
| 14 | 12/04/2003 | APPLICATION RETURN TO OIPE | | | |
| 13 | 12/04/2003 | APPLICATION DISPATCHED FROM OIPE | | | |
| 12 | 12/04/2003 | APPLICATION IS NOW COMPLETE | | | |
| 11 | 10/30/2003 | ADDITIONAL APPLICATION FILING FEES | | | |
| 10 | 10/30/2003 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 9 | 07/07/2003 | CLAIM PRELIMINARY AMENDMENT | | | |
| 8 | 10/01/2003 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 6 | 09/17/2003 | CASE CLASSIFIED BY OIPE | | | |
| 5 | 09/17/2003 | CLEARED BY OIPE CSR | | | |
| 4 | 09/17/2003 | CASE CLASSIFIED BY OIPE | | | |
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|---|------------|--------------------------------------|--|--|--|
| 3 | 09/17/2003 | CLEARED BY OIPE CSR | | | |
| 2 | 09/06/2003 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 07/07/2003 | INITIAL EXAM TEAM NN | | | |

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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